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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,131	01/03/2007	Tom Parkinson	1075-P0008	5635
36067	7590	12/22/2009		
DALINA LAW GROUP, P.C. 7910 IVANHOE AVE. #325 LA JOLLA, CA 92037			EXAMINER KLAYMAN, AMIR ARIE	
			ART UNIT 3711	PAPER NUMBER
			NOTIFICATION DATE 12/22/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/576,131	Applicant(s) PARKINSON, TOM	
	Examiner AMIR KLAYMAN	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Examiner has treated the claim limitation of claim 1 under 35 U.S.C 112 sixth paragraph.
2. Examiner withdraws his objection to the specification. The amended abstract is acceptable.
3. Examiner withdraws his objection to claim 10.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-13 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson US 5588646 in view of Oyarzabal US 4966367.

Dickson teaches a practice device having a ball tethered to two elastic cords secured to a support structure in fig 1; wherein the ball is secured/fasten within the cords while forming a "Y" shape, best shown in fig 4

As per claim 1, Dickson discloses a practicing device (see abstract) comprising: first elastic cord 33 and second elastic cord 32 in fig 1; wherein, each cord is secured to itself in the ball point area 26 in figs 4 and 4A, also col 2, ln 33-36; see also examiner's markings below;

a ball 26 with two means for receiving the cords 32 and 33 as opening holes in
figs 4 and 4A;

both cords are secured to a vertical support; wherein the first cord 33, is secured
to vertical pole 20 in fig 1;

with respect to the second cord 32 being secured to a vertical support, examiner
construed the height of the pole 25 above the ground surface to be the vertical support
means, see examiner's markings below;

both cords, 33 and 32 forming a "Y" shape in figs 1, 4 and in col 2, ln 44-55.

Dickson does not disclose that the two means for receiving the cords are loops
as described by the applicant in fig 2 indication number 14. Dickson's invention is in the
field of a tethered ball batting practice device such as baseball or softball in col 1, ln 56-
57. A skilled artisan would have been motivated to look at other tethered ball batting
practice devices such as in Oyarzabal. Oyarzabal discloses a tethered ball batting
practice device for use in baseball, softball, tennis, handball, racquetball or shuttlecock
(col 2, ln 23-26) where the ball is tethered by two means for receiving cords via loops
42a in figs 3 and 4.

It would have been obvious at the time the invention was made to one of ordinary
skill in the art to modify Dickson's means for receiving the cords in the tethered ball
using the well known means of loops in the tethered ball as taught by Oyarzabal, for the
reason that a skilled artisan would have been motivated to provide a simple substitution
of one known element in securing a tethered baseball or softball (Dickson's means for

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receiving cords using opening in the practice ball as shown in 4) for another (Oyarzabal's means for receiving the practice ball using loops as shown in figs 3 and 4) to obtain the predictable results of securing the practice ball to the elastic cords to form the practice device.

As per claims 2, 3 Oyarzabal discloses the receiving means, loops 42a located on the periphery of the ball on opposite sides, in figs 3 and 4.

As per claims 4, 12, Dickson discloses the elastic cords 32 and 33 having anchoring means of eye bolt 28 (i.e. clip) secured to the support surface, best shown in fig 3a; see col 3, ln 60 to col 4, ln 1-6 three or more eye bolt 28 to anchor the cords to the support frame.

As per claim 5, Dickson discloses the securing means to be a square knot, as best shown in fig 4A and in col 4, ln 17-21.

With respect to the definition of the word tape, the dictionary defines tape as: a long, narrow strip of linen, cotton, or the like, used for tying garments, binding seams or carpets, etc.

Thus, Dickson's square knot tying meets this description of being a tape and therefore meets the claimed limitation of claim 5.

As per claim 6-9 the combination Dickson and Oyarzabal teach the touching engagement of the elastic cords to the tethered ball forming the “Y” shape; see Dickson’s fig 4A and col 2, ln 44-55. The combination Dickson and Oyarzabal do not teach the specific claimed ranges of distance between the engagement points to the ball or the distance between the two supports. However, as the court had held, claims which fell within the broad scope of the references were held to be unpatentable there over because, among other reasons, there was no evidence of the criticality of the claimed ranges of weight or proportions; see *In re Hoeschele*, 406 F.2d 1403, 160 USPQ 809(CCPA 1969). Thus, the claimed distances are obvious in view of the unspecified distances in Dickson’s “Y” shape (figs 1 and 4).

Applicant needs to provide evidence that these specific distance ranges are essential in constructing applicant's invention.

As per claim 10, Dickson discloses the height of the device can be determined by a user/player in col 2, ln 51 to col 3 ln 35. Also, figs 2, 2b, and fig 3 describing that the height of member 21 is determined by pin 27 which further determines the height of ball 26.

As per claim 11, the combination Dickson and Oyarzabal are silent regarding the manufacturing of the flexible cords material. However, as the court had held, the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*,

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325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960) selection of a known plastic to make a container of a type made of plastics prior to the invention was held to be obvious.

Thus, a skilled artisan would have been motivated in using the well known bungee type material in forming the cords for the reason that the bungee type material is known for being flexible and elastic and Dickson describes their cord as flexible (col 1, ln 56-67) and Oyarzabal describes their cord as elastic (col 2, ln 1-4).

As per claim 13, Oyarzabal discloses that a tethered ball batting practice device that is used for baseball can also be used for tennis in col 2, ln 23-25 ; thus, it would have been obvious to use a tennis ball in the combination Dickson and Oyarzabal because of Oyarzabal's explicit teaching where ball B is a tennis ball in fig 2.

As per claim 15, Dickson discloses a number of separate sections of elastic cord in achieving the "Y" shape using the square knot section in figs 4 and 4A to secure practice ball 26, and in col 4, ln 12-21 the use of different end sections of the cords to achieve the "Y" shape.

As per claim 16, Dickson discloses a practicing device (see abstract) comprising:
a ball 26 with two means for receiving the cords 32 and 33 as opening holes in figs 4 and 4A;

first elastic cord 33 and second elastic cord 32 in fig 1; wherein, each cord is secured to itself in the ball point area 26 in figs 4 and 4A and also in col 2, ln 33-36; see also examiner's markings below;

both cords are secured to a vertical support; wherein the first cord 33, is secured to vertical pole 20 in fig 1;

with respect to the second cord 32 being secured to a vertical support, examiner construed the height of the pole 25 above the ground surface to be the vertical support means, see examiner's markings below;

both cords, 33 and 32 forming a "Y" shape in figs 1, 4 and in col 2, ln 44-55.

Dickson does not disclose that the two means for receiving the cords in the ball are loops as described by the applicant in fig 2 indication number 14. However, it would have been obvious to substitute Oyarzabal's loops in the tethered ball for the means for receiving the cords in Dickson for the reasons described above with respect to the rejection of claim 1.

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dickson US 5588646 in view of Oyarzabal US 4966367 as applied to claim 1 above, and further in view of Amron US 5553848.

As per claim 14, the combination Dickson and Oyarzabal do not teach that the ball is soccer ball. However, Amron discloses a practice device using a soccer ball in

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the abstract and in fig 5B soccer ball 80, where Amron's practice device is in the field of striking an object such as soccer ball, baseball, softball and tennis ball in col 3, ln 64-67.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the combination Dickson and Oyarzabal's practice ball as a soccer ball as taught by Amron, for the reason that a skilled artisan would have been motivated to provide a simple substitution of one known element (tennis or baseball/softball ball as taught by the combination Dickson and Oyarzabal) for another (Amron's soccer ball) to obtain the predictable results of having a practice device suitable as a striking device where Amron teaches that sports that involve striking an object includes soccer, baseball, softball and tennis in col 3, ln 64-67.

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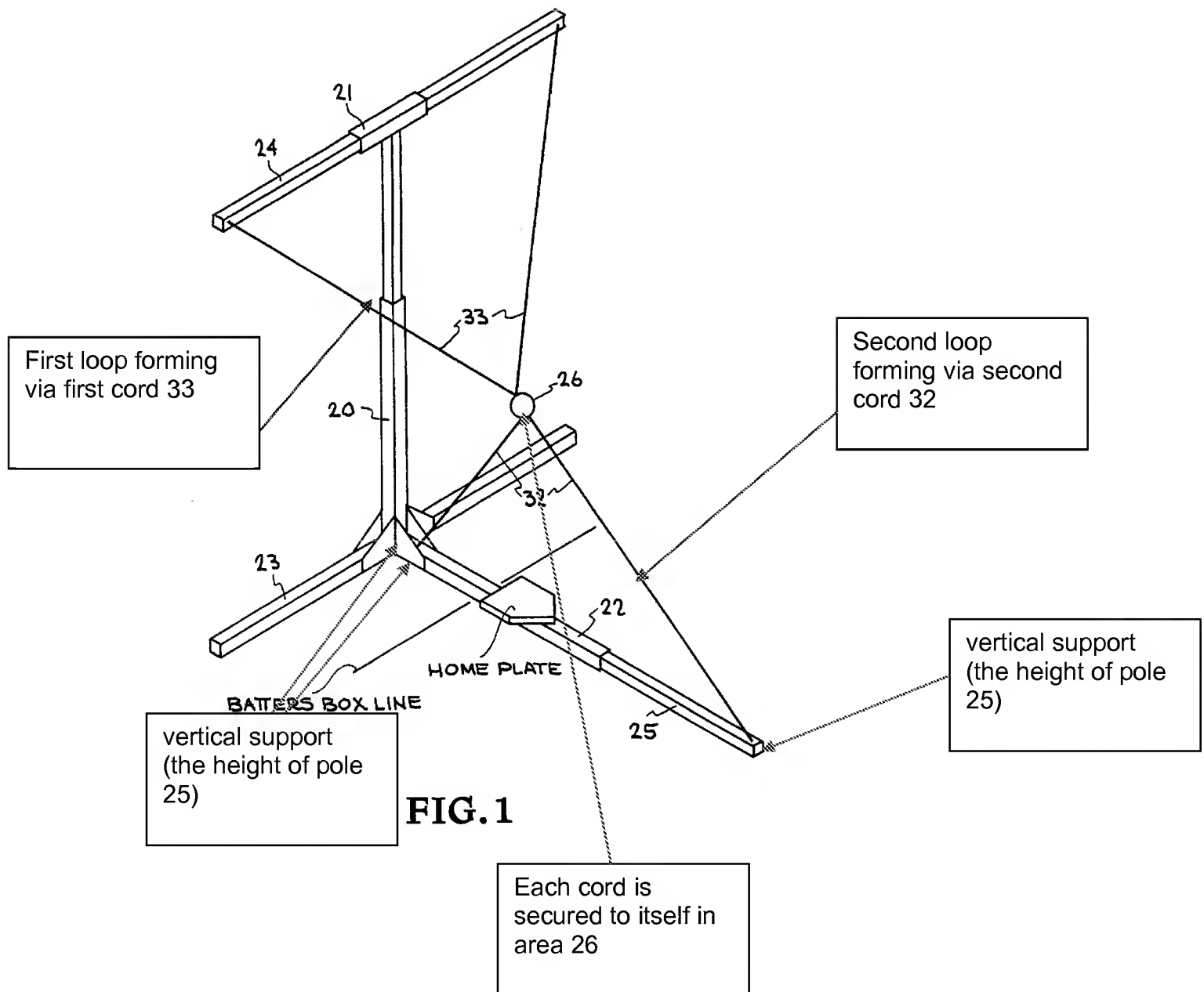
Examiner's markings

U.S. Patent

Dec. 31, 1996

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Response to Arguments

7. Applicant's arguments with respect to claims 1-16 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMIR KLAYMAN whose telephone number is (571)270-7131. The examiner can normally be reached on Mo.- Fr. (7:30AM-5:00PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene KIM can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711